



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/773,880 Confirmation No. 7460
First Named : Phil Verinsky
Inventor
Filed : 2/6/2004
TC/A.U. : Optical Drive Controller Art Unit 2185
with a host Interface for
Direct Connection to an
IDE/ATA Data Bus
Examiner : Thuan N. Du
Docket No. : 3551.P006C3
Customer No. : 08791

MS: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

NOTIFICATIONS OF RELATED LITIGATION UNDER MPEP § 2001.06 (C)

Examiner:

A. ITC Proceedings and Appeal Therefrom to the CAFC regarding the
5,581,715 Patent

The ITC instituted an investigation (337-TA-409) on May 13, 1998 regarding patent number 5,581,715 (which issued based on a parent of this application).¹ The ALJ issued his Initial Determination² on May 12, 1999 and his Recommended Determination

¹ There was also a prior ITC investigation regarding this patent (337-TA-401). However, the issues raised in the 337-TA-401 are subsumed in the ITC investigation discussed at length herein (337-TA-409)

² Listed on the IDS as: Initial Determination cover, In the Matter of CERTAIN CD-ROM CONTROLLERS AND PRODUCTS CONTAINING THE SAME II, Inv. No. 337-TA-409, U.S. International Trade Commission, Public Version, stamp dated 6/11/99, Table of Contents and pages 73-75.

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FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the MS: Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on August 4, 2004.

Name: Jane Wolfe

Signature: *Jane Wolfe*

Date: August 4, 2004

Concerning Respondent's Motion for Sanctions³. Pursuant to a petition for review, the Commission issued on September 27, 1999 a Notice of Final Determination⁴ (followed by a Commission Opinion⁵ and a Denial of Motion for Sanctions; Vacatur of Recommended Determination⁶). (The attached Notice of Final Determination provides a convenient brief summary of the proceedings). Oak Technology, Inc. filed an Appeal to the CAFC regarding the issue of non-infringement (Appeal No. 00-1078; captioned Oak Technology, Incorporated, Appellant v. International Trade Commission, Appellee and Media Tek, Inc., United Microelectronics Corp., Lite-On Technology Corp. and AOpen, Inc., Intervenor). Attached hereto is an IDS submitting the related materials from these proceedings.

Of course, there are additional materials beyond what is enclosed. If any such additional materials are desired, applicant will make its best effort to provide such documents upon request. For example, Applicant has a lengthy list of patents that were produced during the ITC proceedings. Since these patents were deemed not relevant to the disposition of the of the ITC proceeding, Applicant has not submitted them.

In order to expedite the handling of this application, Applicant provides below a description of the ITC findings regarding certain of the documents submitted herewith. Importantly, the Commission reversed the ALJ's findings of invalidity based on an on-sale bar under 35 U.S.C. § 102(b), anticipation under 35 U.S.C. § 102(a), obviousness under 35 U.S.C. § 103, derivation under 35 U.S.C. § 102(f); and reversed the ALJ's

³ Listed on the IDS as: Recommended Determination Concerning Respondent's Motion for Sanctions, In the Matter of CERTAIN CD-ROM CONTROLLERS AND PRODUCTS CONTAINING SAME – II, Inv. No. 337-TA-409, U.S. International Trade Commission, Public Version, stamped received date 10/22/99, (61 pp. total)

⁴ Listed on the IDS as: Notice of Final Determination and attached Order, In the Matter of CERTAIN CD-ROM CONTROLLERS AND PRODUCTS CONTAINING THE SAME – II, Inv. No. 337-TA-409, U.S. International Trade Commission, Corrected Version, stamp dated 9/28/99, (9 pp. total)

⁵ Listed on the IDS as: Commission Opinion, In the Matter of CERTAIN CD-ROM CONTROLLERS AND PRODUCTS CONTAINING SAME – II, Inv. No. 337-TA-409, U.S. International Trade Commission, Public Version, stamped received 10/20/99, (89 pp. total)

⁶ Listed on the IDS as: Denial of Motion for Sanctions; Vacatur of Recommended Determination, In the Matter of CERTAIN CD-ROM CONTROLLERS AND PRODUCTS CONTAINING SAME – II, Inv. No. 337-TA-409 (2 pp.) attached Order (2 pp.) and attached Certificate of Service (1 pp.), U.S International Trade Commission, stamp received dated 12/13/99.

finding of unenforceability due to inequitable conduct before the PTO.⁷ (For a brief summary of these issues, see page 5 of the Commission Opinion). Each of these reversals as it relates to the reference submitted herewith is briefly discussed below.

Reversal of the ALJ's Finding Of Invalidity Based on an On-Sale Bar under 35 U.S.C. § 102(b)

The Commission stated "The Supreme Court has held that an on-sale bar requires proof of two facts: (1) the product must be the subject of a commercial offer for sale, and (2) the invention must be ready for patenting. *Pfaff v. Wells Elc., Inc.*, 119 S.Ct. 304, 311-312 (1998)."⁸ The documents submitted herewith related to the first prong are listed on the IDS as:

Offer for Sale, letter dated 5/19/93 to David D. Tsang, President, Oak Technology, from Masafumi Kaneko, General Manager, Optical Media Product Division, NEC Home Electronics Co., Ltd. (3 pages), Memorandum signed by David D. Tsang on 5/27/93 and Masafumi Kaneko on 5/28/93 (1 page)

Memorandum dated 4/20/94 to Don Bryson, cc: Scott Alberts, Mike Hetzel, From Peter Brown, Re: Barrier Plan (2 pages)

The documents submitted herewith relied upon by the ALJ in his Initial Determination and reviewed by the Commission regarding the second prong are listed on the IDS as⁹:

1) Draft Proposed American National Standard -- AT Attachment Prepared by X3T9 - I/O Interface, Accredited Standards Committee - X3 Information Processing Systems (56 pp.), 2/10/92, X3.221-199x, X3T9.2/90-143.

2) Sanyo LC8950 & LDC8951, Real-Time Error Correction and Host Interface Processors for CD-I and CD-ROM Applications, Application Note No. E89, Sanyo Electric Co., Ltd. Semiconductor Division, First English edition: April 1988, Revised to include LC8951: June 1989 (118 pages), Contents (i-ii), List of Figures (iii-iv), List of Tables (v)

⁷ The Commission also affirmed the ALJ's finding that there is a domestic industry with respect to the '715 patent; affirmed the ALJ's finding of no literal infringement and no infringement under the doctrine of equivalents; and reversed the ALJ's finding of indefiniteness and vagueness under 35 U.S.C. § 112(1), (2), and (6).

⁸ See page 51 of the Commission Opinion.

⁹ See page 52 of the Commission Opinion and pages 74-75 of the Initial Determination.

- 3) Information concerning Oak's ITO-012 CD-ROM controller:
- a) Oak Technology, Inc. OTI-012 Overview dated 11/11/91 (2 pgs.), 5 diagrams (5 pgs.), Oak Technology, Inc. Memorandum to: Mr. Sugie @ Mitsumi Dallas Office, from: Phil Verinsky @ Oak Technology, Inc., Date: 3/10/92, CC: James Ou, Aki Tanaka, Peter Brown, Kenji Fujimoto, Subject: OTI012 Production Package (3 pp. & 2 pp. of diagrams)
 - b) Oak Technology, Incorporated Preliminary Specification OTI-012 CD-ROM Controller Chip, 3/20/92, Copyright 1992 Oak Technology, Inc. Printed in USA (72 pp.), Table of Contents (1 p.), Overview (1 p.), Appendix (A-1 to A-3)
- 4) Proposal for a Working Draft, Revision A1.3, 6/10/93, 11:32 am, ATAPI CD-ROM Standard, Deposition Exhibit 653 Shahani, 10/9/98 (130 pp.), Table of Contents (pp. 3-6), List of Tables (pp. 7-8), List of Figures (pp. 9-10)
- 5) Information concerning the Mitsumi Prototype:
- a) Memorandum dated 2/19/93 pertaining to the Mitsumi prototype, To: P. Verinsky, CC: M. Case, W. Wang, From: A. Tanaka, Re: IDE Prototype Summary (4 pages)
- 6) US Patent Number 5,805,921 issued to Kikinis et al.
- 8) Information concerning the OTI-011:
- a) OTI-011 IDE CD-ROM Controller Engineering Specification Rev. 1.1, 11/2/92 (19 pp.), Contents (1 p.), Overview (1 p.)
 - b) OTI-0E11 microcontroller controller register chart showing the OTI-011 registers for communication with a microcontroller (RX-10C; RX-16C; RX-22C, RX-153C ("CD ROM Interface Status),(4/21/93) (5 pp.)
 - c) OTI-0E11 IDE Interface Control Registers (from the microcontroller's perspective) (2 pp.)
 - d) Oak employee Don Smith's 2/93 design notes describing the OTI-011 registers, including the direct access feature for the PDIAG, DASPEN, and clear BSY signals (RX-20C; Verinsky 1029-1032),(1 page)
 - e) Claimed inventor Verinsky's 3/93 IDE/Host Checklist referring to an HIRQ pin for generating host interruption requests (RX-17C; Verinsky Tr. 1032-1034, (2 pp.)

Although it was determined that there was evidence for a finding of an offer for sale, the Commission found that there was no on-sale bar under 35 U.S.C. § 102 because the invention disclosed in the '715 patent was not "ready for patenting" before the critical

date as that term is defined in *Pfaff*. For more information, see pages 51-55 of the Commission Opinion.

Reversal of the ALJ's Finding Of Invalidity Based on Anticipation under 35 U.S.C. § 102(a)

The issue of invalidity based on anticipation under 35 U.S.C. § 102(a) was also considered with respect to the Mitsumi prototype (see the document above numbered 5). The Commission found that there was not clear and convincing evidence that the Mitsumi prototype anticipated claim 1.¹⁰

Reversal of the ALJ's Finding Of Invalidity Based on Obviousness under 35 U.S.C. § 103

The documents of the attached IDS relied upon by the ALJ and reviewed by the Commission regarding this issue were the documents above numbered 1-6.¹¹

The Commission determined that the ATAPI specification is not prior art to the '715 patent.¹² In addition, the Commission determined that the various asserted combinations of the above references did not render the patent invalid under 35 U.S.C. § 103.¹³

Reversal of the ALJ's Finding Of Invalidity Based on Derivation under 35 U.S.C. § 102(f)

The documents of the attached IDS relied upon by the ALJ and reviewed by the Commission regarding this issue were the documents above numbered 4 & 5.¹⁴ The Commission reversed the ALJ's finding that the claims in issue of the '715 patent are invalid for derivation under 35 U.S.C. § 102(f).

¹⁰ See pages 55-58 of the Commission Opinion.

¹¹ See page 59 of the Commission Opinion.

¹² See pages 60-62 of the Commission Opinion.

¹³ See pages 60 and 62-64 of the Commission Opinion.

¹⁴ See pages 64-67 of the Commission Opinion.

Reversal of the ALJ's Unenforceability Due to Inequitable Conduct before the PTO

The documents of the attached IDS relied upon by the ALJ and reviewed by the Commission regarding this issue were the documents above discussed regarding the on-sale activity and the documents above numbered 2-5.¹⁵

As a result of the Commission's determination regarding Applicant's behaviour regarding these documents, the '715 patent remains enforceable.¹⁶ These issues are further elaborated upon in the Denial of Motion for Sanctions; Vacatur of Recommended Determination (attached and previously cited above).

B. Northern District of California Proceeding Regarding the 5,581,715 Patent

In another litigation the defendants have been permitted to raise issues related to patent number 5,581,715. Specifically, the case of Oak Technology, Inc. v. United Microelectronics Corporation (97-20959 RMW) is pending in the Northern District of California. Although the initial allegations related to patent number 5,581,715 were dismissed from this case, the court ruled to permit United Microelectronics to enter claims of invalidity and unenforceability regarding patent number 5,581,715 as a defense to Oak's claim of fraud.¹⁷ These claims are essentially the same invalidity and unenforceability positions rejected by the International Trade Commission.¹⁸ Specifically, the attached IDS includes: 1) Oak Technology Inc.'s Claim Construction Brief; 2) Defendant United Microelectronics Corporation's Opening Brief on Claim Construction; 3) Oak Technology Inc.'s Response to Defendant United Microelectronics Corporation's Invalidity Contentions Dated June 28, 2002; and 4) Defendant United

¹⁵ See pages 77 of the Commission Opinion.

¹⁶ See page 83 of the Commission Opinion.

¹⁷ Although the decision by the court to allow entry of these claims was originally dated December 14, 2001, the court later realized that it had not been provided to the parties or properly included in the proceedings. Thus, the court reissued the order.

¹⁸ While some of these documents were originally under seal, that seal was lifted as evidenced (see the Order Re Unsealing of Case File listed on the attached IDS).

Micro Electronics Corporation's Invalidity Contentions.¹⁹ While Oak Technology Inc.'s Response relies on the Commission Opinion²⁰ (previously submitted) that rejected the earlier ALJ's Initial Determination²¹ (previously submitted) of invalidity and unenforceability, the Defendant United Micro Electronics Corporation's Invalidity Contentions relies on sections of the overturned ALJ's Initial Determination. (See Applicant's summary above).

Applicant includes additional documents to provide additional detail.²² As before, there are additional materials beyond what is enclosed. If any such additional materials are desired, applicant will make its best effort to provide such documents upon request.

¹⁹ There are certain attachments of these documents that are not included. If there are any questions regarding any of these attachments, please let Applicant know.

²⁰ Commission Opinion, In the Matter of CERTAIN CD-ROM CONTROLLERS AND PRODUCTS CONTAINING SAME – II, Inv. No. 337-TA-409, U.S. International Trade Commission, Public Version, stamped received 10/20/99, (89 pp. total)

²¹ Initial Determination cover, In the Matter of CERTAIN CD-ROM CONTROLLERS AND PRODUCTS CONTAINING THE SAME II, Inv. No. 337-TA-409, U.S. International Trade Commission, Public Version, stamp dated 6/11/99, Table of Contents and pages 73-75.

²² The additional documents include:

- 1) Notice of Motion and Motion for Summary Judgment that the '715 Patent is invalid under 35 U.S.C. § 112, ¶¶ 1, 2 & 6 (and Declaration of James C. Otteson in Support of UMC's Motion for Summary Judgment that Oak's '715 Patent is invalid under 35 U.S.C. § 112, ¶¶ 1, 2 & 6);
- 2) Oak Technology, Inc.'s Motion for Summary Judgment Against UMC's Patent Defense to Oak's Fraud Claims (and Declaration of Michael J. Songer in Support of Oak Technology, Inc.'s Motion for Summary Judgment Against UMC's Patent Defense to Oak's Fraud Claims);
- 3) Oak Technology, Inc.'s Opposition of UMC's Motion for Summary Judgment that Oak's '715 Patent is invalid under 35 U.S.C. § 112, ¶¶ 1, 2 & 6 (and Declaration of Michael J. Songer in Support of Oak's Opposition to UMC's Motion for Summary Judgment that Oak's '715 Patent is invalid under 35 U.S.C. § 112, ¶¶ 1, 2 & 6);
- 4) Reply Brief in Support of UMC's Motion for Summary Judgment that the '715 Patent is Invalid Under 35 U.S.C. § 112, ¶¶ 1, 2 & 6 (and United Microelectronics Corporation's Objection to "Evidence" Offered by Oak Technology, and Reply Declaration of James C. Otteson in Support of UMC's Motion for Summary Judgment that the '715 Patent is invalid under 35 U.S.C. § 112, ¶¶ 1, 2 & 6);
- 5) Oak Technology, Inc.'s Submission of Declaration of Robert G. Wedig in Support of Oak Technology, Inc.'s Motion for Summary Judgment Against UMC's Patent Defense to Oak's Fraud Claims;
- 6) United Microelectronics Corporation's Opposition to Oak Technology, Inc.'s Motion for Summary Judgment on UMC's Patent Defense to Oak's Fraud Claim (and Declaration of James C. Otteson in Support of Microelectronics Corporation's Opposition to Oak Technology, Inc.'s Motion for Summary Judgment to UMC's Patent Defense to Oak's Fraud Claim); and
- 7) Oak Technology, Inc.'s Reply in Support of Oak's Motion for Summary Judgment Against UMC's Patent Defense to Oak's Fraud Claim.

C. ITC Proceedings regarding the 6,584,527 and 6,546,440 Patents

A complaint was filed with the ITC (investigation number 337-TA- , dated 3/11/2004)²³ regarding patent numbers 6,584,527 and 6,546,440 (which issued based on a parent of this application). A response was filed.²⁴

D. Central District of California Proceeding Regarding the 6,584,527 and 6,546,440 Patents

A complaint was filed in the Central District of California regarding patent numbers 6,584,527 and 6,546,440.²⁵

²³ Complaint under Section 337 of the Tariff Act of 1930, as Amended; In the Matter of Certain Optical Disk Controller Chips and Chipsets and Products Containing Same, Including DVD Players and PC Optical Storage Devices, United States International Trade Commission Washington, D.C., Investigation No. 337-TA-, dated 3/11/2004 (35 pgs)

²⁴ Public Version of Response to Complaint and Notice of Investigation Under Section 337 of the Tariff Act of 1930, as Amended, United States International Trade Commission Washington, D.C. Before the Honorable Paul J. Luckern, Administrative Law Judge, Investigation No. 337-TA-506, dated 5/4/2004 (48 pgs)

²⁵ Zoran Corporation and Oak Technology, Inc. v. Mediatek, Inc., Mintek Digital, Inc., Asustek Computer, Inc., Lite-On Information Technology Corp., Teac Corporation, Teac America, Inc., Terapin Technology PTE., LTD. Corporation and Teraoptix L.P. d/b/a Terapin Technology, First Amended Complaint for Patent Infringement; Demand for Jury, United States District Court, Central District of California, Southern Division, Case No. SA CV 04-0313 GLT (RCx), Exhibit 1 and Exhibit 2, dated 5/20/2004, filed 5/21/2004 (114 pgs)

Invitation for a telephone interview

The Examiner is invited to call the undersigned at 408-720-8598 if there any questions regarding this material.


Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 8/3, 2004



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